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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/927,292

08/13/2001

Marc A. Messner

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7590

06/07/2005

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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,292

Applicant(s)

MESSNER, MARC A.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to Applicant's response, filed on 03/24/2005.
2. Claims 1-3 are pending.
3. The rejection to claims 1-3 under 35 U.S.C. 102 (e) as being anticipated by Wang U.S. Pat. No. 6,282,656 as set forth in the Office action mailed on 09/18/2005 is maintained.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
5. Claims 1-3 are rejected under 35 U.S.C. 102 (e) as being anticipated by Wang (U.S. pat. No. 6,282,656).

As per claim 1 Wang discloses a method for completing a transaction request pertaining to an electronic transaction conducted over an electronic network having a server and a

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requesting device. A portable electronic authorization device for executing approval transaction request (which is readable as Applicant's claimed invention wherein said an electronic apparatus for providing security of specified electronic transactions), comprising:

An article removably (item 200) inserted into the personal electronic apparatus, the article bearing machine readable code (see., figs 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39);

Customer-specific code installed on and retained by the personal electronic apparatus, the code affecting operation of the personal electronic apparatus (see., figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically encryption code or logic);

Verifying means for determining whether the article is installed in the personal electronic apparatus, and if so, for enabling specified electronic transactions, but, if not, for preventing said transactions (see., figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically wherein said approval transaction device associated with the requesting terminal..., fig 11);

Whereby, upon a request for specified electronic transactions by the user, the personal electronic apparatus queries whether the article is installed, and, if so, enables specified transactions to be performed at the request of the user, but prevents the transaction from being performed if the article is not installed (see., figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically wherein said

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approval transaction device associated with the requesting terminal..., fig 11, col 15, lines 30-67, col 16, lines 8-55).

As per claims 2-3 Wang discloses a method for completing a transaction request pertaining to an electronic transaction conducted over an electronic network having a server and a requesting device. A portable electronic authorization device for executing approval transaction request (which is readable as Applicant's claimed invention wherein said a method of purchasing goods and services via the Internet), comprising: Providing the personal electronic apparatus of claim 1; creating a customer account at a bank pursuant to communication with the customer and relaying to the customer a pin number (figs 1, items 108 and 109) that will be required in a later step (see., fig 1, col 2, lines 9-61. Please note that item 108 is for inserting a PIN number; creating customer-specific software at the bank, then splitting the software into a first portion, which is written to the article and a second portion which is transmitted to a bank download server; mailing the article to the customer (fig 1, item 107), who then inserts it into the personal electronic apparatus; the customer contacting the bank (fig 9, items 902 and 904) download server via internet and downloading the second portion to the personal electronic apparatus, then the bank download server erasing the copy of the second portion, from the download server, but retaining relevant information on a bank purchase server; and upon provision of the pin number by the customer, the personal electronic apparatus linking the first and second portion into working software on the

personal electronic apparatus (see., figs 3A, 3B, fig 4 and fig 9, abstract, col 5, lines 10-67, col 7, lines 8-39, col 14, lines 48-67, col 15, lines 1-67.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 03/24/2005 have been fully considered but they are not persuasive.

REMARKS

7. In response to Applicant's arguments, Applicant argues that the prior art of record (Wang 656") fails to anticipate or render obvious the recited feature:

a. " a personal electronic apparatus comprising an article with machine readable code".

However, the Examiner respectfully disagrees with this assertion since Wang discloses this limitation in the abstract, col 1, lines 10-67, col 3, lines 5-60, specifically wherein said a method for completing a transaction request pertaining to an electronic transaction conducted over an electronic network having a server and a requesting device. A portable electronic authorization device for executing approval transaction request, and also figs 3A, 3B and fig 4.

b. Applicant continues to argue that the prior art of record Wang fails to disclose: " customer-specific code installed on and retained by it". As indicated above, Wang discloses this limitation in figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically encryption code or logic). Applicant should note

that the portable electronic authorization device (item 200) of Wang has customer code installed on for executing approval transaction request.

Conclusion

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

June 04, 2005